



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

REPLY BRIEF FOR THE APPELLANTS

Ex parte Paul KALAPATHY et al.

PIPELINED SEARCHES WITH CACHE TABLE

Serial No. 09/985,763

Appeal No.: Unknown

Group Art Unit: 2616

In the event that there may be any fees due with respect to the filing of this paper, please charge Deposit Account No. 50-2222.

Peter Flanagan
Attorney for Appellants
Reg. No. 58,178

SQUIRE, SANDERS & DEMPSEY LLP
8000 Towers Crescent Drive, 14th Floor
Tysons Corner, VA 22182-2700

Atty. Docket: 58268.00097

PCF/mmi

Encls: Reply Brief

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Appellants:

Confirmation No.: 4336

Paul KALAPATHY et al.

Appeal No.: Unknown

Serial Number: 09/985,763

Group Art Unit: 2616

Filed: November 6, 2001

Examiner: Hong Sol CHO

For: PIPELINED SEARCHES WITH CACHE TABLE

REPLY BRIEF

March 13, 2007

I. INTRODUCTION

This is Appellants' Reply Brief in an appeal from a final rejection set forth in an Official Action dated July 19, 2006, ("the Office Action") finally rejecting claims 1-25, all of the claims pending in this application, as being unpatentable. A response to the Office Action was timely filed on August 9, 2006, ("the Response"). An Advisory Action was mailed on August 23, 2006, maintaining the above rejections and providing a brief response to some of the arguments presented in the response.

A Notice of Appeal and Pre-Appeal Brief Request for Review were timely filed on October 19, 2006. A Notice of Panel Decision was mailed November 13, 2006, bearing the signature and initials of only two examiners, and permitting the appeal to continue. An Appeal Brief was timely filed within two months of the filing of the Notice of Appeal, on December 19, 2006 ("the Appeal Brief"). An Examiner's Answer was mailed on March 9,

2007 (“the Examiner’s Answer”).

Although the Examiner’s Answer fails to address certain of the arguments set forth in the Appeal Brief, the Examiner’s Answer contains a few comments, in the “Response to Arguments” section, that provide a basis for demonstrating the strength of Appellants’ position, or raise new issues. The present Reply Brief is, therefore, being timely filed within two months of the mail date of the Examiner’s Answer.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The Examiner’s “Grounds of Rejection” (Section 9 of the Examiner’s Answer) is simply a verbatim repetition of the Final Rejection. Accordingly, section 9 of the Examiner’s Answer itself does not meaningfully address Appellants’ arguments set forth in Section VIII of Appellants’ Appeal Brief. However, the Response to Arguments section of the Examiner’s Answer Section 10 provides both new points that require further clarification, and comments that strengthen Appellants’ position.

III. RESPONSE TO ARGUMENTS

The Examiner’s Answer, at pages 6-7, item 10, provides response to some of the arguments provided by Appellants, and its responses both raise new issues and strengthen Appellants’ position. Thus, this Reply Brief is supplemental (not substitutionary) with regard to the Appeal Brief and is submitted in reply to the new points of Argument raised by the Examiner.

A. The Examiner Construes Michels Contrary to the Michels' Disclosure

The Examiner's Answer admitted that "Michels shows the primary memory as separate and outside of search engine in figure 3" Nevertheless the Examiner's Answer stated that the rejection is "interpret[ing] the primary memory as part of a search device." The difference between the reference's disclosure (memory is separate and outside of the search device) and the Examiner's interpretation (memory is part of the search device) could not be more obviously contradictory. Accordingly, it is respectfully submitted that none of the rejections can be maintained, and it is respectfully requested that all of the rejections be reversed.

B. The Cited Reference's Disclosure regarding number of search cycles

The Examiner's Answer, at page 6, correctly noted that Michels states that there is no requirement that the number of iterations be distributed equally across search engines. Specifically, Michels states "Still further, the partitioning of iterations across search engines need not be equal." Nevertheless, Michels provides only examples in which the partitioning is equal, and does not provide any example in which a first number of cycles is less than a second number of cycles. Thus, it can be seen that Michels' comment is simply a patentese anti-limitation: a statement made to avoid limiting the scope of Michels' invention, not a suggestion to vary from the best mode described in Michels.

Accordingly, one of ordinary skill in the art would not be motivated to modify

Michels disclosed embodiments simply based on the patentese non-limitation language quoted above. Even if one of ordinary skill in the art would recognize the possibility of making the iterations unequal, Michels does not provide the slightest indication that such a modification would be desirable.

As MPEP Section 2143.01 indicates, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In the cited reference there is not the slightest indication that making the first number of cycles less than the second number of cycles would be desirable, and no disclosure of such an embodiment is provided. Thus, under MPEP 2143.01, a *prima facie* case of obviousness has not been established. Accordingly, it is respectfully requested that the rejection of claims 3, 5, 9, 11, 14, 18, and 20 be withdrawn.

C. The Examiner's Assertion regarding the Single Substrate Feature is Wrong

The Examiner's Answer, at page 7, asserted that the "single semiconductor feature" is not dependent on the disclosure of the present application. Applicant respectfully but firmly disagrees. This Honorable Board may observe the dependence upon the present application's disclosure at page 5 of the Rejection, third paragraph, where the Rejection stated: "APA discloses implementing various modules, interface, and tables onto a single semiconductor substrate (specification, paragraph [0055], lines 1-7)." (See also the identical rejection at page 5 of the Examiner's Answer, last paragraph.)

Appellants have proved, and the Examiner's Answer does not dispute, that paragraph [0055] of the specification present application is not Admitted Prior Art (APA). Furthermore, it is clear from an examination of the Rejection that the Rejection does not rely upon "the concept of implementing the various modules of Michels into a single semiconductor substrate as general knowledge of one of ordinary skill in the art."

Furthermore, in rejecting claims under 35 U.S.C. § 103, the USPTO bears the initial burden of presenting a *prima facie* case of obviousness. *See In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting **evidence** that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. *See In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious **must be supported by evidence**, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. *See In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted **without hindsight reconstruction** of the invention from the prior art. The USPTO may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. *See In re Warner*, 379 F.2d 1011, 1017,

154 USPQ 173, 178 (CCPA 1967).

The present rejection, however, is self-evidently hindsight reconstruction based on paragraph [0055] of the present application. There is no acceptable evidence of record, including no takings of "Official Notice" to support the rejection of claims 22-25. The single evidence that was previously pointed to was impermissible, because it was Appellants' own disclosure. Accordingly, it is respectfully submitted that the rejection of claims 22-25 does not have an evidentiary basis, and, therefore, must be reversed.

IV. CONCLUSION

As fully explained in the Appeal Brief, each of claims 1-25 recites one or more elements or features that are neither disclosed nor suggested in the cited references.

The Office Action's analysis is unreasonable and legally errant, because it combines references using prohibited hindsight reconstruction and because it improperly characterizes the cited art. This final rejection being in error, therefore, Appellants respectfully requests that this honorable Board of Patent Appeals and Interferences reverse the Examiner's decision in this case and indicate the allowability of application claims 1-25.

This Reply Brief has been submitted to highlight new issues raised by the Examiner's Answer. The Appeal Brief provides a complete explanation of the patentability of the claims, and stands unrebutted. Thus, no argument should be deemed waived simply because it is not repeated in the Reply Brief.

In the event that this paper is not being timely filed, the Appellants respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees which may be due with respect to this paper may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

SQUIRE, SANDERS & DEMPSEY LLP


Peter Flanagan
Attorney for Applicants/ Appellants
Registration No. 58,178

Atty. Docket No.: 58268.00097

8000 Towers Crescent Drive, 14th Floor
Tysons Corner, VA 22182-2700
Tel: (703) 720-7800
Fax (703) 720-7802

PCF:mmi